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PRE-APPEAL BRIEF REQUEST FOR REVIEW

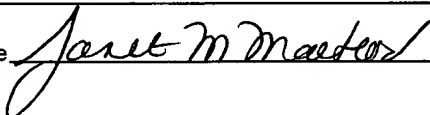
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14249

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on July 18, 2005

Signature



Typed or printed name

Janet M. MacLeod

Application Number

09/719,960

Filed

June 14, 2001

First Named Inventor

Peter Hagerlid

Art Unit

1655

Examiner

B. Sisson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

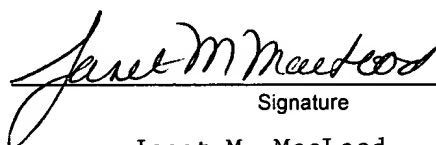
attorney or agent of record.

Registration number 35,263

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Signature

Janet M. MacLeod

Typed or printed name

212-415-9200

Telephone number

July 18, 2005

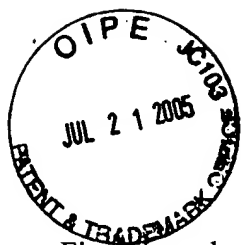
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.☐

*Total of forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named
Inventor: Peter Hagerlid

Appln. No.: 09/719,960

Group Art Unit: 1655

Filed: June 14, 2001

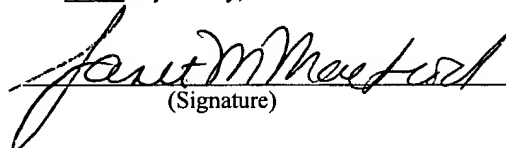
Examiner: B. Sisson

Title: REACTION MONITORING SYSTEM

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

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(Signature)

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program at OG Notice: July 12, 2005, Applicants request review of the final rejection in the above-identified application for the reasons stated below.

Claims 23, 24, 27-35 and 46 stand finally rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by U.S. Patent No. 5,874,219 to Rava et al. ("Rava et al.") in view of U.S. Patent No. 5,556,961 to Foote et al. ("Foote et al."). Claims 37-39 have been objected to as allegedly dependent upon a rejected base claim.

The rejected claims are directed to an apparatus for simultaneously monitoring an array of reaction sites for light comprising a sample receptacle comprising an array of reaction sites and masking means between the reaction sites; a dispenser; an optically sensitive transducer; a light intensity level determination device; and a recorder.

The rejection contends that Rava et al. disclose an apparatus comprising an array of test sites on a chip and further comprising an array of pixels of a CCD, which in turn detects signals

resulting from a chemical reaction. Foote et al. is alleged to teach of incorporating a mask into an array such that the mask has areas of transparency and opacity, where the areas of transparency correspond to the reaction sites. The Examiner contends that it would have been obvious to have incorporated the mask of Foote et al. with the apparatus of Rava et al., and that one would have been motivated by the teaching of Foote et al. that photolithographic masks are easily prepared and positioned with precision.

Applicants respectfully submit that a prima facie case of obviousness has not been established because: 1) the prior art references do not teach or suggest all of the claim limitations; and 2) there would not have been motivation to combine the references.

Rava et al. fail to teach or suggest an apparatus in which a single optically active transducer is arranged so that light emitted from a plurality of samples impinges upon corresponding predetermined regions of a transducer. Further, Rava et al. fail to teach or suggest a light intensity determination device for simultaneously determining the level of light intensity impinging upon each of the predetermined regions. See, e.g., Amendment filed December 13, 2004 at pages 5 to 6.

Foote et al. fail to teach or suggest a masking means between reaction sites on an array. Foote et al. teach a photolithographic method for the synthesis of an array. In the method disclosed by Foote et al., a photolithographic mask is used for the preparation of a microarray of chemical products in which cells and boundaries are defined by chemical reactivity and nonreactivity, respectively. The photolithographic mask is not incorporated into the array, nor do transparent areas of the photolithographic mask correspond to reaction sites in an array. See, e.g., Response filed July 15, 2005 at pages 5-8.

There is no motivation in the prior art to combine the references. The Examiner's allegation that one would have been motivated to combine the references because Foote et al. teach that photolithographic masks are easily prepared and can be precisely positioned is legally insufficient. See, e.g., Response filed July 15, 2005 at pages 4-6.

Rava et al. repeatedly and specifically teach away from the use of masking means, and thus it is clear that one would not have been motivated to combine its teachings with those of Foote et al. See, e.g., Response filed July 15, 2005 at pages 4-6.


For all of the foregoing reasons, Applicants submit that the rejection of record contains clear error, and that more than one essential element of a prima facie rejection is lacking. This case is thus appropriate for review by an appeal conference prior to the filing of an appeal brief.

Applicants respectfully request that an appointed panel of examiners review the rejection, the remarks herein, the application and its file history, and issue a decision allowing the present claims.

Respectfully submitted,

DORSEY & WHITNEY LLP

Date: July 18, 2005

By: 
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